

Notice of Allowability

Application No.

10/806,452

Examiner

Helene Klemanski

Applicant(s)

TAGUCHI ET AL.

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1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to amendment and terminal disclaimer filed July 18, 2005.
2. ☒ The allowed claim(s) is/are 1,3-7 and 11-16.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

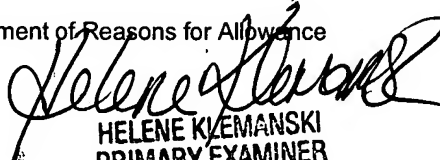
Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____


HELENE KLEMANSKI
PRIMARY EXAMINER
GROUP 1700

DETAILED ACTION

Terminal Disclaimer

1. The terminal disclaimer filed on July 18, 2005 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of any patent granted on Applications No's. 10/611,990, 10/807,442, 10/805,251, 10/600,831, 10/660,653 and 10/806,424 has been reviewed and is accepted. The terminal disclaimer has been recorded.

REASONS FOR ALLOWANCE

2. The following is an examiner's statement of reasons for allowance: This application teaches an ink comprising water, a water-soluble organic solvent, a dye, a non-ionic surfactant and a betaine compound wherein the dye has at least two heterocyclic groups and at least one of the heterocyclic groups contains at least one of pyridine, thiophene, thiazole, benzothiazole, benzoxazole and furan rings. The closest prior art of record is EP 1378550, EP 1375608, EP 1473336 and U.S. Patent Application Publication No's. 2004/0055508, 2004/0011248 and 2004/0080595, issued to Miyamoto et al., Taguchi et al. and Taguchi et al. respectively, however, applicants have filed a certified English translation of their foreign priority which entitles them to a date of September 30, 2002 which is earlier than any of the effective filing dates of the above EP references or U.S. Patent Application Publication No's. Accordingly, the 102(a) and the 102(e) rejections over each of the above references have been overcome and the application is allowable. Gundlach et al. teaches a similar ink

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composition containing a betaine compound but fails to teach or suggest the addition of a non-ionic surfactant as claimed by applicants. Hiraoka et al. teaches a similar ink composition containing a betaine compound but fails to teach or suggest a dye containing at least two heterocyclic groups and at least one of the heterocyclic groups contains at least one of pyridine, thiophene, thiazole, benzothiazole, benzoxazole and furan rings as claimed by applicants.

Applicants should note that the examiner has cited U.S. Patent Application Publication 2005/0178288, issued to Taguchi however no rejections have been made over this reference since the filing date of the above reference is after the filing date of the instant application (i.e. no 102(e) rejection). The only possible rejection would be an obviousness type double patenting rejection and as per MPEP 804, if this is the only remaining rejection then the instant application should be passed to issue.

Applicants should also note that the examiner has cited U.S. Patent No. 6,923,854, issued to Taguchi et al. however no rejections have been made over this reference since applicants have overcome the provisional obviousness type double patenting rejection made over US 2005/0001890 (PGPub of above US Patent) in the Office Action dated February 17, 2005 by filing a terminal disclaimer and have also overcome the 102(e) rejection over US 2005/0001890 in the Office Action dated February 17, 2005 by the filing of a certified English language translation.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably

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accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helene Klemanski whose telephone number is (571) 272-1370. The examiner can normally be reached on Monday-Friday 5:30-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Helene Klemanski
Primary Examiner
Art Unit 1755


HK
September 26, 2005